

AMENDMENTS TO THE DRAWINGS

Please amend the drawings as reflected in the Appendix enclosed herewith.

As discussed below, Applicants have corrected Figures 1-3 to include further labeling as required by the Examiner.

REMARKS

Applicants wish to thank Examiner Fischetti for extending the courtesy of an interview to Applicants' representative, Pablo Tapia, on October 13, 2005 and on October 19, 2005. Examiner suggested that limitations positively stating the relationship between the entertainment environment and the resort facility should be included. Applicant has addressed the Examiner's observations. As discussed below, the Examiner and Applicant's representative also conversed regarding the drawings and the newly added claims.

Claims 1-18 have been canceled without prejudice or disclaimer.

Claims 19-52 are newly added and present no new matter.

Reconsideration of the rejections and objections set forth in the Office Action dated July 13, 2005 is respectfully requested.

Applicants submit that the claims are in condition for allowance.

Drawings

The Examiner has objected to the drawings because boxes are left blank without wording in Figures 1-3, and 8. On October 13, 2005, Applicant's representative interviewed with Examiner regarding this objection. Examiner agreed that the objection to Figure 8 should be withdrawn but maintained the objections to Figures 1-3.

Applicants traverse the Examiner's objection to Figures 1-3 for the following reasons. There is no requirement in the U.S. Code, or in the Code of Federal Regulations, to label boxes as the Examiner has required.

In particular, 37 C.F.R § 1.83, entitled "Content of drawing," reads as follows:

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the

invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).

Applicants submit that the language in this section refers to “conventional features” which do not need “detailed illustration” can be illustrated as a graphical drawing symbol. In the alternative, they can be illustrated as a labeled representation. The labeling of a rectangular box is given as an example. All of the boxes in Figures 1-3 have been labeled (with reference numerals and description in the specification). Therefore, Applicants submit that all the boxes have been labeled or are graphical drawing symbols. The Examiner’s attention is respectfully drawn to Applicants’ issued patent U.S. Patent No. 5,502,806 wherein some of the drawings are identical drawings as those now being rejected by the Examiner.

In order to advance prosecution, however, Applicants have corrected Figures 1-3 to include further labeling as required by the Examiner. As such, Applicants request that the objection to the drawings be withdrawn.

Canceled and new claims

While Claims 1-18 have been canceled without prejudice, Applicants have introduced new claims which include similar subject matter. During the interview of October 19, 2005 Examiner Fischetti and Applicants’ representative Pablo Tapia agreed that Claims 19 and 35 are substantially the same claim as canceled Claim 1. As such, it was agreed that Claims 19 and 35 would be entered. Claims 20-34 depend from Claim 19. Claims 36-50 depend from Claim 35. Therefore, Applicants submit that dependent Claims 20-34 and 36-50 should also be entered.

Applicants have further added new independent Claims 51 and 52 which also recite similar matter as canceled Claim 1. Therefore, Applicants submit that Claims 51 and 52 should be entered.

Claim Rejections – 35 U.S.C. § 112

Claims 11, 12, and 14 were rejected under 35 U.S.C. § 112, second paragraph. These rejection is moot in light of the cancellation of the rejected claims.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner states that Claims 1-10, 12, and 13 under 35 U.S.C. 103(a) are unpatentable over Mahoney (U.S.P.N. 5,502,806) in view of Decker (U.S.P.N. 6,167,443). The Examiner also states that Claims 11, 14-16 under 35 U.S.C. 103(a) are unpatentable over Mahoney in view of Decker in further view of Christie (U.S.P.N. 5,502,806).

The rejected claims have been cancelled. However, Applicants have added new Claims 19-52 which are believed to be patentable over the cited references.

As a preliminary matter, the Examiner is respectfully reminded of basic principles when combining two references in order to reject a claim:

“The ‘as a whole rule’ prevents evaluation of the invention part by part. Without this important requirement, an unobviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art component. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result – **often the essence of invention.**” Judge Rader – *Princeton Biochemicals Inc. v. Beckman Coulter Inc.*, (Fed. Cir. 1995)(emphasis added).

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

With this in mind, Applicants respectfully submit that new Claims 19-52 are patentable over the cited references for at least the following reasons.

1. Mahoney does not suggest a desirability to combine

“The teaching or suggestion [1] to make the claimed combination and [2] the reasonable expectation of success must **both** be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” As such, the question is whether one

of ordinary skill in the art would have been, at the time the invention was conceived, motivated by an implicit or explicit teaching or suggestion found in the prior art to combine the references as combined by the Examiner. Furthermore, the second requirement set by the Federal Circuit mandates that a reasonable expectation of success must also be taught in the prior art.

In order to combine the system of Mahoney with Decker, Mahoney must express (implicitly or explicitly) a desirability to utilize television units as part of their ordering system. Mahoney expresses no suggestion or teaching to utilize television units instead of computer terminals. Furthermore, since the teaching of such combination is not present in Mahoney or Decker, there could not be a reasonable expectation of success.

Applicants submit that one of ordinary skill in the art would not have been motivated to combine Mahoney and Decker because neither Mahoney nor Decker teach or suggest the combination or a reasonable expectation of success.

2. The combination does not teach all of the elements

But even if Mahoney was combined with Decker, such combination would not teach the elements of the present application. In particular, the combination of Mahoney and Decker would not teach at least the following limitations: 1) the priority request being entered on a television unit located at the resort facility, and 2) a television unit located at the resort facility where the resort facility is located remotely from the entertainment environment.

- 1) The combination does not teach the priority request being entered on a television unit located at the resort facility.

Mahoney in view of Decker does not teach the priority request being entered on a television unit located at the resort facility. Claims 19, 35, 51 and 52 recite that the priority request is entered on a television unit located at the resort facility.

The Examiner recognizes that “Mahoney fails to disclose using a television in association with the input device 42.” Further, the Examiner states that “Decker does disclose using a

television to order items remotely off a television located in the room of the patron.” Applicants respectfully disagree.

Decker does not teach or disclose using a television to order times remotely. Rather, the television unit in Decker is simply used as an output device, not as an input device that the user can utilize to request video. The Examiner’s attention is respectfully drawn to the following excerpts from the text of the disclosure of Decker:

“Each individual user may contact operators 30 at the central operations 10 by establishing a communication link 80 utilizing telephone lines or another communication network such as a private high-speed network.” (See Decker, Column 3, Lines 49-53).

“The headend controller 180 operates as follows when a user selects a movie for viewing. The system controller 140 receives the user's designation via telephone 101 and accessory 102, the PBX 250, and the interactive board 260 as described below.” (See Decker, Column 9, Lines 29-34)(emphasis added).

“Referring back to FIG. 2, the process of selecting a video is begun after the user is directed either by previews on the in-room television 100 or by cues at or near the in-room telephone 101 or television 100 to access the system 60 by pressing the appropriate button on the telephone accessory 102.” (See Decker, Column 9, Lines 66-67, and Column 10, Lines 1-4)(emphasis added).

“No further identification signal is sent by the telephone accessory 102 during selection of a video. The user is then cued by the system controller 140 to depress appropriate buttons on the telephone 101. These tones produced thereby represent user responses to the controller 140 cues.” (See Decker, Column 10, Lines 15-20)(emphasis added).

Indeed, the television unit in Decker is not used as an input device to order the video, but rather simply as the output device. The input device in Decker is a telephone not the television unit. The Examiner is therefore incorrect in assuming that the television unit is used for ordering the movie, and therefore be used as an input device. As such, the combination does not teach the

priority request being entered on a television unit located at the resort facility because the television of Decker is not as an input unit.

Moreover, if Mahoney were combined with Decker, Mahoney would simply cease to work for its intended purpose. The computer terminals in Mahoney would be television units as disclosed in Decker. As previously stated, the television units of Decker do not work as input devices. Thus if the television units of Decker are used in combination with Mahoney, the system in Mahoney would be rendered inoperable because patrons would not be able to enter their requests. Because combining Decker with Mahoney would cripple Mahoney's system, there is no motivation to combine these two references. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Thus, there is not motivation to combine Mahoney and Decker because when combined, Mahoney is unsatisfactory for its intended purpose.

In addition, when combined, not only is Mahoney's system inoperable, but such combination would not teach the priority request being entered on a television unit located at the resort facility.

2) The combination does not teach a television unit located at the resort facility where the resort facility is located remotely from the entertainment environment.

Mahoney in view of Decker does not teach a television unit located remotely from the entertainment environment. Claims 19, and 35 recite that the resort facility is located remotely from the entertainment environment, and further that the television unit is at the resort facility. Thus, the television units are located remotely from the entertainment environment.

If Mahoney were combined with Decker, the television units would be inside the park, not remotely away from the park. Mahoney does not indicate that the computer terminals can be outside of the park. On the contrary, Mahoney teaches that the computer terminals would be within the park: "The card satellite terminals 22, 24 and 26 are located *within* the theme park 40

but not in the waiting line area of a specific ride, event or food service outlet.” Therefore, Mahoney in combination with Decker does not teach a television unit located remotely from the entertainment environment.

In Mahoney, if the computer terminals were to be located outside of the park, such modification would change the principle of operation of Mahoney. The Federal Circuit has been clear regarding modifications that would change the principle of operation of a prior art reference. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). (See also 2143.01 § IV, V).

Accordingly, Applicants submit that Mahoney in combination with Decker does not teach a television unit located at the resort facility where the resort facility is located remotely from the entertainment environment.

At least for the foregoing reasons, Applicants submit that independent Claims 19, 35, 51 and 52 are not rendered obvious by Mahoney in view of Decker. Claims 20-34 depend from Claim 19. Claims 36-50 depend from Claim 35. Therefore, Applicants submit that dependent Claims 20-34 and 36-50 are not rendered obvious by Mahoney in view of Decker either. Therefore, Applicants submit that Claims 19-51 are in condition of allowance.

Conclusion

Applicants have complied with all requirements made in the above referenced communication. Applicants submit that the present application is in condition for allowance, and therefore, respectfully request that a timely Notice of Allowance be issued in this case. Should matters remain, which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicants’ undersigned agent.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to Deposit Account Number **50-2638**. Please ensure that Attorney

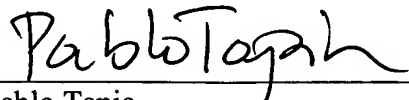
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PATENT

Docket Number 58085-010203 is referred to when charging any payments or credits for this case.

Respectfully submitted,

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